

REMARKS/ARGUMENTS

Specification

The Examining Attorney has requested that the addition to the specification on page 1 be cancelled as "new matter". The Applicant respectfully requests the Examining Attorney reconsider this request because the addition is not new matter for multiple different reasons. The following is the referenced paragraph and the only change was the insertion of "not" where it is clear it was intended anyway:

It is also desirable to provide an application system in which the same components or parts are not exposed to multiple different identifier labels because it may be difficult to clean or remove all the particles from one application before the next application is commenced.

Anyone reading the sentence would recognize that it does not make sense if the same components or parts "are exposed". If there is a concern as stated that it would be "difficult to clean or remove all the particles from one application before the next application is commenced, then it is only logical and implied that the application system preferably does NOT expose the same components or parts to multiple different labels. One skilled the art would easily recognize the existence of said error in the specification and that the term "not" should be included therein.

This amendment is an amendment to correct an obvious error and therefore does not constitute new matter. *In re Oda*, 443 F.2d 1200, 170 USPQ 268 (CCPA 1971); MPEP 2165.06.

Furthermore, the context of the error is a description of an application system in which the invention is trying to avoid the difficulty of cleaning or removing all the particles from one application before the next application is commenced, and it is contrary to that goal or desire to expose the same components or parts to multiple different labels. It is therefore also inherent in the context and language that the components or parts "not" be exposed to multiple different identifier labels. An application may later be amended to recite the function, theory or advantage of an item without introducing prohibited new matter. *In re Reynolds*, 443 F.2d 384, 170 USPQ 94 (CCPA 1971); *In re Smythe*, 480 F. 2d 1376, 178 USPQ 279 (CCPA 1973).

Therefore the Applicants submit that the amendment does not introduce any new matter and should not be cancelled.

Section 112 Rejections

The Examining Attorney has rejected claims 24 – 35 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention, and also as failing to comply with the enablement requirement. The Applicant respectfully requests the Examining Attorney reconsider these rejections based on the arguments set forth below.

The Examiner has not met his burden to support a lack of enablement rejection. The legal test is whether the disclosure contained sufficient information regarding the subject matter of the claims as to enable one skilled in

the pertinent art to make and sue the claimed invention. In the art, it is far fetched to

Furthermore, the term "microdot" has been used in several prior applications and is well known in the art. A few examples of which are U.S. Patent No.'s 5,429,392, 4,243,734, and 6,461,987.

The law as established by the U.S. Supreme Court (*Mineral Separation v. Hyde*, 242 U.S. 261 (1916)), requires that the question be asked as to whether undue or unreasonable experimentation is needed to practice the invention. That test is not and cannot be met with this rejection.

Furthermore a patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661 (Fed Cir. 1991).

In this case, making this rejection in light of prior applications and issued patents not imposed with this restriction, treats these applicants differently than others have been treated, in violation of the equal protection clause of the U.S. Constitution. The Fourteenth Amendment, Section 1, of the Constitution of the United States, grants it citizens equal protection and equal treatment under the laws, and provides in relevant part:

All persons born or naturalized in the United States, and subject to the jurisdiction thereof, are citizens of the United States . . . nor deny to any person within its jurisdiction ***the equal protection*** of the laws

The examiner's treatment of applicants' use of microdot in this application is a disparate or unequal treatment than the Patent Office has given other similar uses, as referenced above, which is a violation of the Equal Protection Clause of the United States Constitution.

This invention may work with any one of a number of different types, kinds or configurations of known microdots, and others. Applicants therefore respectfully request that the rejection be removed.

Claims 24 & 33 Rejected Under Section 112, Second paragraph.

The Examining Attorney has rejected claims 24 and 33 because the specification fails to disclose "predetermined microdots" as set forth in the claims, and the metes and bounds of the claims cannot be determined. For the reasons stated above, the term microdot is well known and used in the industry and those of ordinary skill in the art understand this term for any specific application. The Applicant respectfully requests the Examining Attorney reconsider these rejections based on the arguments set forth above as those of ordinary skill in the art understand the metes and bounds.

Anticipation - Section 102(b) Rejection

The Examining Attorney has rejected claims 24 – 28 and 30 - 35 as being anticipated by Inglis (956,101). The Applicant respectfully requests the Examining Attorney reconsider this rejection based on the arguments set forth below.

First of all, with respect to claim 24 and all claims that depend from claim 24 (claims , there is nothing in Inglis or in McRitchie which teaches, discloses or suggests drawing the mixture. The Applicants looked at several systems for use

with microdots, and this system was found to work in the application of microdots where others did not work as well. Therefore the examiner has not met his *prima facie* case that, claim 24 and the claims that depend on claim 24, are anticipated by Inglis or McRitchie.

The Inglis and McRitchie references do not disclose each and every element of the claimed invention, as required for a *prima facie* case of anticipation. There is no disclosure of the "drawing" identified by the examiner from either reference, and as expressly required by claim 24 and claims depending from claim 24 (i.e. claims 25-32), a There is no anticipation if the reference does not disclose each and every element of the claimed invention. SSIH Equipment S.A. v. United States International Trade Commission, 718 F.2d 365, 218 U.S.P.Q. 678 (1983).

With respect to independent claim 33, the examiner has not pointed out how either the Inglis nor the McRitchie references individually or collectively, include each of the following elements of the method:

... releasably coupling the inlet portion of the passage to the outlet of a supply of air as a dynamic fluid, feeding air through the passage from the air supply so that the air flowing through the passage causes the mixture to be displaced from the container body into the passage for discharge through the discharge portion for application to the first article, and when application to the first article has been completed, disconnecting the inlet portion of the discharge part from the air supply outlet and disposing of the first container consisting of body and discharge part of the second container to the said outlet of the air supply to discharge the mixture for application to the second article, and, when application to the second article has been completed, disconnecting the inlet portion of the discharge part, and providing a second like container having a body containing a plurality of a predetermined microdots therein discrete to a second article and adhesive fluid into which the microdots are mixed to form a mixture, releasably coupling the inlet portion of the discharge part of the second container from the air supply outlet and disposing of the container body and discharge part of the second container body, wherein

application of the discrete microdots to the respective articles can be accomplished without contamination with microdots from a preceding application using the same air supply.

Therefore the references do not constitute a prima facie case of anticipation.

Still further, the applicants submit that neither Inglis nor McRitchie anticipate this invention for the following additional reasons:

1. Inglis and McRitchie are not known or capable of performing the function of this invention, nor does it teach the disclosure of this invention, that is applying microdots by the methods claimed by either claim 24 or claim 33. There is no anticipation by a prior patent not known or recognized as being capable of performing the function of the patented device, but rather the prior patent must itself do the teaching. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 221 U.S.P.Q. 385 (1984); Edstrom-Carson & Co. v. Onsrud Machine Works, Inc., 129 U.S.P.Q. 457.

2. Inglis and McRitchie do not disclose the purpose, means or mechanism that this invention discloses, as discussed above with respect to the drawing of the mixture, or in the use of the method as recited in claim 33. There is no anticipation where a reference does not disclose the purpose, means and mechanism for accomplishing the instant invention but rather is restricted to a limited and different means. Sperry Products, Inc. V. Aluminum Company of America, 120 U.S.P.Q. 362.

3. Inglis and McRitchie do not solve the problems this invention solves, in applying a mixture which includes microdots, nor is it believed that the




inventions disclosed in either reference would sufficiently work to apply microdots. There is no anticipation if a prior patent does not solve the problem(s) which the subsequent patent successfully solves. Technical Development Corporation v. Servo Corporation of America, 125 U.S.P.Q. 133.

Conclusion

Applicant therefore submits Claims 24-35 are in a position to proceed to allowance.

Respectfully submitted,

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